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tesa AG 685-HCL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANTS : SCHÜMANN et al.
SERIAL NO. : 09/736,548
FILED : 13 December 2000
FOR : ADHESIVE TAPE, IN PARTICULAR FOR MAKING A CATHODIC
ELECTROCOAT PRIMER
ART UNIT : 1771
EXAMINER : Victor S. Chang

27 May 2003

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 1.192

SIR:

This is an appeal from the final rejection dated 26 December 2002.

(1) REAL PARTY IN INTEREST

The real party in interest is **tesa AG** which is a subsidiary of Beiersdorf AG. Beiersdorf AG received a Notice of Recordation of Assignment on at Reel 011396, Frame 0717 (Recorded on 13 December 2000).

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

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(3) STATUS OF CLAIMS

Claims 1 and 4-11 stand rejected.

(4) STATUS OF AMENDMENTS

It appears that all amendments have been entered. The After-Final response dated 26 March 2003 included an amendment to the specification which was stated to be entered in the Advisory Action dated 4 April 2003 (Paper No. 13). No amendments were made to the claims in the After-Final response.

(5) SUMMARY OF INVENTION

The present invention as represented by claim 1 relates to an adhesive tape provided on one side with a self-adhesive composition and comprising a backing material comprising a polyester film coated with a crosslinked epoxy resin, wherein:

- the crosslinked epoxy resin is prepared using epoxy resins selected from the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins;

and wherein

- said epoxy resins are cured using a curing agent selected from the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; araliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.

Support for this invention can be found, for example, on page 21 (originally filed claims 1-3)

Support for the subject matter of claims 4-10 can be found, for example on page 21 (originally

filed claims 4-10). Claim 11 reintroduces the deleted "particular preference" ranges of originally filed claim 4.

(6) ISSUES

The lone remaining issue is whether claims 1 and 4-11 are obvious or non-obvious in light of Kinzer et al. (U.S. Patent 5,667,893) alone or in view of Wiest et al. (U.S. Patent 4,322,516).

(7) GROUPING OF CLAIMS

Claims 1 and 4-11 would stand or fall together.

(8) ARGUMENT

Background

Claims 1 and 4-11 remain rejected by the examiner as being obvious over Kinzer et al. (U.S. Patent 5,667,893) alone or in view of Wiest et al. (U.S. Patent 4,322,516 – for claims 6 and 11). As the appellants have stated that the claims would stand or fall together, the appellants direct their arguments against the Kinzer reference which is used to reject claim 1. The appellants request that this rejection be reversed for the following reasons.

Summary of Arguments

MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

However, the appellants maintain that the Kinzer et al. reference differs from the appellants' claimed invention in at least two ways which have not been accounted for by the use of the Kinzer reference.

First, the primary component of the photopolymerizable epoxy composition of the Kinzer reference is a plurality of epoxides (see col. 2, Summary of the Invention) whereas the applicants'

crosslinked epoxy resin is comprised of an epoxy component **and** an amine component.

Second, it is unclear that Kinzer actually teaches a **crosslinked** epoxy resin. Kinzer at best teaches that their epoxy compositions are "photopolymerized". However, there is no indication that this is equivalent to being crosslinked.

Kinzer does not teach an epoxy component AND an amine component

With regard to the first point, the examiner states that the epoxy compositions of Kinzer "...may also include hardeners (i.e. amines), etc. (column 6, lines 17-21)." However, the appellants believe this interpretation fails to consider the teachings of Kinzer "as a whole" which is one of the four tenets of patent law which must be adhered to when applying 35 U.S.C. 103 (see MPEP 2141).

It is first noted that the characterization of hardeners as being equivalent to amines comes from the examiner **not** from the teachings of Kinzer. Furthermore, the recitation of hardeners is within a Markush-like grouping of optional adjuvants (col. 6, lines 17-21 from Kinzer is reproduced below):

Compositions of the invention may also include optional adjuvants such as co-curatives, hardeners, fillers, plasticizers, pigments, antioxidants, surface modifying agents, and the like, in amounts such that they do not interfere with the photopolymerization of the epoxides.

It has long been held that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)). This concept has been more recently been affirmed in *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) - "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention; rather, there must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to

combine them in the way they were combined by the inventor. There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed.Cir.2000); *ATD Corp.*, 159 F.3d at 546, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed.Cir.1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935, 15 U.S.P.Q.2d 1321, 1324 (Fed.Cir.1990) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed composition); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed.Cir.1985)."

For the present situation, there is no teaching or suggestion that:

- (1) the adjuvants are required elements of Kinzer's invention;
- (2) hardeners are preferably selected from the Markush group of adjuvants; and
- (3) the hardener must be an amine.

Further still, given the additional components which are required by Kinzer et al.'s epoxy composition (i.e. "at least one organometallic cationic initiator") and other optional ingredients thereof ("optionally, at least one accelerating agent" (i.e. peroxides) - see col. 5, line 64 - col. 6, line 3 of Kinzer), one of ordinary skill in the art would be directed away from adding an amine component as the applicants' have done as there would be no reasonable expectation of success in making the proposed combination given the required components of Kinzer's invention (see also MPEP 2143.1, page 2100-125, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).") or through the selection of other optional ingredients which are not conducive to the further addition of an amine.

Moreover, even if it were possible to clear the above hurdles, it is noted that the passage from col. 6, lines 17-21 also includes the limitation "in amounts such that they do not interfere with the photopolymerization of the epoxides." Kinzer's claimed invention is directed toward "an article comprising a substrate which has coated thereon a **photopolymerizable** epoxy composition".

There is no indication that Kinzer also contemplates crosslinked epoxy resins as in the appellants' claimed invention. Kinzer defines "photopolymerization" in col. 3, lines 31-35:

1. The term "photopolymerizable" means that a compound or composition is capable of polymerizing (i.e., being fully cured) when irradiated preferably by ultra-violet emissions in the range of from about 180 nm to about 420 nm.

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As such, there is no motivation for one of ordinary skill in the art to select an amine component within the context of Kinzer's invention as this would produce a different epoxy composition than that contemplated by Kinzer.

Therefore, for any of the reasons given above, the appellants' hold that there is no teaching or suggestion to prepare crosslinked epoxy resin prepared by using epoxy resins with an amine.

No evidence that Kinzer teaches a crosslinked epoxy resin

Even if *in arguendo* there was some rationale to "pick and choose" an amine in the teachings of Kinzer, there is nothing within the Kinzer reference which teaches or suggests a crosslinked epoxy resin as in the appellants invention.

If the examiner is relying on inherency to establish that Kinzer et al. teaches a crosslinked epoxy resin via the use of an amine, MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "*The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)...To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*'"*In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), see also *Mentor H/S, Inc. v. Medical Device Alliance, Inc. (Mentor II)*, 244 F.3d 1365, 58 USPQ2d 1321 (Fed. Cir. 2001) and *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

repeat

It is also insufficient to do no more than broadly allege that claim limitations are disclosed in the prior art "either expressly or inherently" as the Federal Circuit noted in *Electro Scientific Industries, Inc. v. General Scanning, Inc.*, 247 F.3d 1341, 58 USPQ2d 1498 (Fed. Cir. 2001).

In the present situation, not only is there no indication by Kinzer of a crosslinked product but there are additional burdens in that:

- (1) the required components of the Kinzer invention differ from that of the appellants' invention, i.e. a plurality of epoxides, amines (*in arguendo*) **and** at least one organometallic cationic initiator; and
- (2) Kinzer appears to teach away from their intended epoxy composition being crosslinked as it is described in their Summary of the Invention that "...the present invention provides an article comprising a substrate coated with a **flexible** epoxy composition."

There has been no 'extrinsic evidence' or detailed reasoning why it should be presumed that if one were permitted to add an amine to the Kinzer invention, one would inherently expect a crosslinked epoxy resin as in the appellants' claimed invention especially in light of the extenuating conditions dictated by the Kinzer reference.

Therefore, even if it is held that amines could be used in the Kinzer invention, this still does not produce the crosslinked epoxy resin of the appellant's invention.

(9) CONCLUSION

For the foregoing reasons, Appellants respectfully request that the Honorable Board reverse the final rejections.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

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ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 E. 42nd Street
30th Floor
New York, NY 10017
(212) 808-0700

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NORRIS, McLAUGHLIN & MARCUS, P.A.

By Julie Harting
Julie Harting
Date May 27, 2003

(10) APPENDIX - CLAIMS ON APPEAL

1. An adhesive tape provided on one side with a self-adhesive composition and comprising a backing material comprising a polyester film coated with a crosslinked epoxy resin, wherein

the crosslinked epoxy resin is prepared using epoxy resins selected from the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins; and wherein said epoxy resins are cured using a curing agent selected from the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; araliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.
4. The adhesive tape according to Claim 1, wherein the crosslinked epoxy resin comprises fillers, plasticizers and, optionally, auxiliaries and additives as further formulating constituents.
5. The adhesive tape according to Claim 1, wherein on the reverse of the crosslinked epoxy resin there is a release coating.
6. The adhesive tape according to Claim 1, wherein the self-adhesive composition has the following makeup:

ethylene	from 10 to 30% by weight
vinyl acetate	from 20 to 55% by weight
acrylic ester	from 30 to 69% by weight
acrylamide	from 0 to 8% by weight.
7. The adhesive tape according to Claim 1, wherein the self-adhesive composition has a thickness of from 15 to 40 μm .
8. A method for masking window flanges which comprises applying the tape of Claim 1 to said flanges.
9. A process for producing the adhesive tape of claim 1, which comprises applying a mixture of

starting components of the epoxy resin during their chemical reaction phase directly on the polyester film.

10. The process of claim 9, wherein the polyester film is provided with the self-adhesive composition prior to coating with the crosslinked epoxy resin opposite the side to be coated with epoxy resin.

11. The adhesive tape of Claim 6, wherein

the amount of ethylene is 10 to 15% by weight,

the amount of vinyl acetate is 30 to 35% by weight,

the amount of acrylic ester is 50 to 60% by weight,

the amount of acrylamide is 0.5% by weight.